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EXAMINER

SAGER, MARK ALAN

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/662,736	Applicant(s) BOZEMAN, ALAN KYLE	
	Examiner M. A. Sager	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-35, 37-50 and 52-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 29-35, 37-50, 52 and 53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Specification

1. A substitute specification excluding the claims is required pursuant to 37 CFR 1.125(a) because due to number of amendments made to specification by applicant during prosecution.

A substitute specification must not contain new matter. The substitute specification must be submitted with markings showing all the changes relative to the immediate prior version of the specification of record. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. An accompanying clean version (without markings) and a statement that the substitute specification contains no new matter must also be supplied. Numbering the paragraphs of the specification of record is not considered a change that must be shown.

Claim Interpretation

2. With respect to claim interpretation for clarification of record, the language 'alphabetical play phrase' (or similar terminology) includes any coherent text or any text or a word or includes an alphanumeric sequence as per Applicants specification (abstract, paragraphs 44, 57, 62-63, 78, 85) that although includes listing as Applicant asserts in remarks rec'd Mar 17, 2006 that the play phrase is quotes, film titles, fortune cookies or even simple list of words fitting a theme as cited from specification (paragraph 81), the language is broader and includes any text at least since that although Applicant may be their own lexicographer, in this instance, Applicant did not provide a clear definition (paragraph 31) and the examples cited in the listing (para 81) are

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merely examples. In consideration of intrinsic evidence, the specification permits letters, alphanumeric, numbers, symbols as characters or indicia and that a player may enter a word or any coherent text can form the play phrase or can be any text at least since specification states a player may write the desired word and states any coherent text (abstract, paragraphs 62-63, 78). Further, in consideration of extrinsic evidence, phrase is defined within Webster's II New Riverside University Dictionary, copyright 1994, to be (1) a sequence of words regarded as a meaningful unit or, (2) a concise or familiar expression: CATCH PHRASE or, (3) a word or group of words read or spoken as a unit and separated by pauses or other junctures or, (4) two or more words in sequence comprising syntactic unit or groups of syntactic units, less completely predicated than a sentence. In consideration of specification as a whole (by itself or, in conjunction with extrinsic evidence), the broadest reasonable interpretation of the claimed invention including 'alphabetic play phrase' (or similar language) is any coherent text that may include a series of letters or alphanumeric or word(s) as being coherent text. Also, a single word is any text and a single word may form a phrase or sentence such as but not limited to GO, NO, STOP, HALT, or further text includes CLOUD 9 or B5 or I12, as broadly claimed. This is not stating each word can form a phrase, but that some words as a singular word may form a phrase or sentence. Further, claims 29-35, 37-50, and 52-53 are limited to a plurality of words. Further, alphabetic of alphabetic play phrase; while, word-based play phrase is deemed to require word(s); however, although alphabetic play phrase requires letters, it is not limited to word(s) and does not preclude use of numbers for at least two reasons. First, as stated above, specification specifically stating use of numbers or alphanumeric as indicia in forms of lottery where word based lottery is clearly another form of lottery and second, the claim language states

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comprising ... alphabetic includes use of letters but fails to preclude numbers by breadth of language and 'alphabetical' does not implicitly preclude. Further, text such as B5, I18, N38, G50, and O72 is an alphabetic play phrase as an alphanumeric sequence from a lotto game deemed inclusive within breadth of claimed invention as including alphabetical phrase and a plurality of words in so far as each indicium is an alphabetic word in context of breadth of instant specification. Also claimed invention including 'play phrase comprising a plurality of words', the breadth of claim language includes a plurality of words that may include words associated or relate to a topic or theme similar to word find or search puzzles that include a plurality of words related to a topic or theme.

Claim Rejections - 35 USC § 102

3. Claims 50, 52-53 are rejected under 35 U.S.C. 102(b) as anticipated by Guttin (6241246) or, in the alternative, under 35 U.S.C. 103(a) as obvious over Guttin (6241246) in view of either Baerlocher (5788573) or Chan (6602133) or Walker (5921864). The prior action is maintained for cited claims as reiterated herein with consideration of amended language. Response to Applicants remarks is provided below and incorporated herein. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims

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cover what a device is, not what a device does.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). In this case, claimed alphabetic play phrase is any text including a plurality of words (*supra*) fails to preclude Guttin since Guttin discloses a lottery ticket (2:43-61, figs. 1-5, refs. 4, 6, 8) having a section listing a alphabetic play phrase as any text comprised of a plurality of words (ref 4) and a random character string having a cover being selectively removable to reveal random character string (ref 6), whereby a prize is associated with each word (ref. 8), wherein the random character string selectively matches a word in the pre-printed play phrase whereby upon such matching a prize associated with the word is won (ref 8), or wherein the random character string selectively containing all characters of a word in the pre-printed play phrase whereby a prize associated with the word is won (ref. 4, 6, 8), as broadly claimed. It is also noted that word puzzles generally relate to a theme or topic where the plurality of words in the word puzzle relate to or are associated with the theme or topic so as to focus player in their search to words with common topic or theme such as exemplified in newspaper (note discussion in Guttin background discusses news puzzles) or the publication Highlights word search/find puzzles. Alternatively, Guttin includes a word-based play phrase including a plurality of words (*sic*); however, where word-based play phrase comprised of a plurality of words includes each of the words of the plurality of words to relate to same topic or theme (not currently limiting as being required), it is not clear whether Guttin plurality of words relate or are associated with a topic or theme. Word games with a plurality of words related to a topic or theme are well known such as themed word [find/search] puzzles as discussed in Guttin (background discussion of newspaper puzzles) or Chan (figs. 4-6) or, alternatively as a phrase having a plurality of words as taught/demonstrated

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in Wheel of Fortune phrase game as discussed by Baerlocher (1:21-27, 4:4) or Walker (abstract, 4:18-19, 23-35). Thus, it would have been obvious to an artisan at a time prior to the invention to add play phrase comprised of a plurality of words where each of the words are associated or related to topic or theme [not currently so limited] as suggested by Baerlocher or Chan or Walker to Guttin so as to increase interest from players for particular topic or theme.

Claim Rejections - 35 USC § 103

4. Claims 29-30 and 32-33 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as being obvious over Koza in view of either Baerlocher (5788573) or Walker (5921864) or alternatively, over Koza in view of either Goldman or Luciano, and further in view of either Baerlocher (5788573) or Walker (5921864). As stated in MPEP 2111.04, claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure. However, examples of claim language, although not exhaustive, that may raise a question as to the limiting effect of the language in a claim are:

- (A) “adapted to” or “adapted for” clauses;
- (B) “wherein” clauses; and
- (C) “whereby” clauses.

The determination of whether each of these clauses is a limitation in a claim depends on the specific facts of the case. In *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005), the court held that when a “whereby” clause states a condition that is material to patentability, it cannot be ignored in order to change the substance of the invention.” *Id.* However, the court noted (quoting *Minton v. Nat’l Ass’n of Securities Dealers*,

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Inc., 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003)) that a “whereby clause in a method claim is not given weight when it simply expresses the intended result of a process step positively recited.”” In this instance, ‘wherein the alphabetical play phrase comprises a plurality of words’ as best understood does not limit invention to a particular structure since the play phrase is not structure of apparatus but rather indicia of game thus pertains to use of apparatus; however, the claimed ‘wherein... plurality of words’ is treated herein as discussed below.

Also as stated MPEP 2114, while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board’s finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). “[A]pparatus claims cover what a device is, not what a device does.” Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). In this case, the amended language ‘wherein the alphabetical play phrase comprises a plurality of words’ does not pertain to structure of apparatus but rather pertains to use of the apparatus in playing a lotto game and further alphabetical play phrase includes any text or a plurality of words or includes letters or alphanumeric sequence (sic), Koza discloses a apparatus and method for playing a lottery game (2:51-3:20, 3:64-4:4, 4:13-5:28, 6:9-12, 6:21-39, 11:28-68, 12:36-13:30) teaching claimed features or steps, as broadly claimed, including a game input unit, a wager input device and a

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controller as stated below, where the alphabetical play phrase comprising a plurality of words is indicia used in process of playing lottery game that fails to limit structure of apparatus claimed. For instance, for those singular words that can also be a phrase, Koza discloses a apparatus for playing a lottery game where the alphabetic play phrase includes a word selected from a list such as a menu or is sequence that includes letters or a plurality of indicia such as a sequence of numbers whereby a plurality of numbers form the indicia to match (3:68-4:2, 5:10-12, 6:9-12, 7:26-11:38, 12:35-13:2), a game input unit device for receiving a random alphabetic play phrase from user such as keyboard or play slip (3:10-20, 3:50-52, 6:9-29, 11:36-38, 11:60-68, 12:46-63, ref 72), a wager input device such as coin slot (11:40), a controller operatively coupled to game input and wager input (11:28-13:2, fig. 1-6, or inherent, per MPEP 2131.01, see either Goldman 3:61-5:40, ref 12; or Luciano, 2:66-3:9, 5:66-6:3, 7:20-9:15, ref 130), the controller generating a random character string and assigning a prize value to the alphabetical play phrase (3:10-20, 5:26-28, 5:31-32, 49-51, 7:25-66, 8:4-11 or inherent, per MPEP 2131.01, see either Goldman 3:61-5:40, ref 12; or Luciano, 2:66-3:9, 5:66-6:3, 7:20-9:15, ref 130), and the controller determining a payout value based upon the correlation among the character string, the play phrase, the prize value and the wager (3:10-20, 4:51-54, 5:24-28, 6:32-39, 7:25-66, 8:4-11, 11:28-13:2 or inherent, per MPEP 2131.01, see either Goldman 3:61-5:40, ref 12; or Luciano, 2:66-3:9, 5:66-6:3, 7:20-9:15, ref 130). Further, regarding determining a payout value, Koza provides a payout value based upon a correlation among the character string, the alphabetical play phrase, the prize value and the wager as a matching of letter grouping (sic). It is noted that Applicants' instant specification includes determining a payout value based upon matching letter group or grouping (paragraph 69 and 77) that is one form of determining a payout encompassed

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by clam language in a similar manner taught by Koza, thus claimed functional recitation in apparatus fails to preclude Koza. Further, regarding controller, although Koza may not explicitly state inclusion of controller, however, the office maintains Koza infers a controller since Koza does state the information [winning indicia] provided to transmitter is computer controlled (5:50-51), a recording of such selection at a central repository which is a central computer storing player selections that would include a processor for receipt of transmitted player selections (11:28-31) and Koza states drawing of random numbers is every hour on all 365 days a year (7:30-34). It is maintained that the repetitive hourly drawings infer being done automatically by a computer that is economically speaking best suited to such task where a lotto gaming authority is very keen on bottom line profit and where excessive labor cost would not be tolerated. To conduct the 8760 (8784 during leap years) drawings manually or at least without a controller (to automate) year after year as suggested by Applicant would seem to incur labor cost that an automated system would not incur. Inherency is maintained as stated above. Applicant's lack of reading Koza as a whole is noted.

However, alternatively, where Koza conducts 8760 (8784 during leap year) drawings without a controller [or logic circuit or other processor], the excessive labor cost involved with a manual or semi manual drawing operation would not be incurred by a system or process that includes a controller [or logic circuit or other processor] that is operatively coupled to game input unit and the wager input device, being capable of generating a random character string and assigning a prize value to the alphabetical play phrase, also determining a payout value upon the correlation among the character string, the play phrase, the prize value and the wager. Such automated systems are notoriously well known in the art such as demonstrated by either

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Goldman or Luciano. Goldman discloses a lottery game apparatus teaching a game input unit for receiving a random indicia from a user such as manually input by the user that includes numbers or other indicia (3:38-47), a wager input device (3:47-49, 52-56), a controller operatively coupled to game input unit and wager input device, the controller capable of generating a random character string and assigning a prize value to indicia, the controller also determining a payout value based on correlation among character string, indicia, prize value and wager (3:57-4:9, 4:26-5:50, 6:43-7:23, 7:48-8:32); while, Luciano discloses a lottery game apparatus teaching a game input unit for receiving a random indicia from a user such as manually input by the user (2:38-42, ref. 102), a wager input device (ref. 104), a controller operatively coupled to game input unit and wager input device, the controller capable of generating a random character string and assigning a prize value to indicia, the controller also determining a payout value based on correlation among character string, indicia, prize value and wager (2:66-3:9). Thus, it would have been obvious to an artisan at a time prior to the invention to add a controller operatively coupled to game input unit and the wager input device, being capable of generating a random character string and assigning a prize value to the alphabetical play phrase, also determining a payout value upon the correlation among the character string, the play phrase, the prize value and the wager as suggested/taught by either Goldman or Luciano to Koza to automate generation of winning indicia and determination of winning status without incurring undue labor expense thereby increasing profitability of game.

Alternatively, Koza or Koza in view of either Goldman or Luciano discloses a apparatus and method for playing a lottery game (2:51-3:20, 3:64-4:4, 4:13-5:28, 6:9-12, 6:21-39, 11:28-68, 12:36-13:30) teaching claimed features or steps, as broadly claimed, including a game input

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unit, a wager input device and a controller as stated above (sic), however, Koza teaches use of indicia as either numbers or a word and a word may also be a phrase. It is maintained that Koza or Koza in view of either Goldman or Luciano teaches claimed structure and the functional recitation regarding 'wherein... a plurality of words' pertains to process of use of apparatus that fails to patentably distinguish in so far as indicia is selected and compared to determine matching as conventional and claimed for lottery. Thus, the alphabetical play phrase comprising a plurality of words is indicia used in process of playing lottery game that fails to patentably distinguish structure of apparatus claimed (MPEP 2114) or the process of play (MPEP 2111.04) since the type of indicia used in playing lottery game such as a play phrase comprising a plurality of words is deemed design choice since the type of indicia used does not alter/limit the structure of claimed apparatus or the process of play of lottery is not changed in so far as (in summary) user makes wager and selects indicia to match with system determined indicia to determine degree of any winnings due in part based on degree of matching between player selected indicia, system selected indicia and wager where the use of letters rather than numbers [or use of letters in conjunction with numbers (alphanumeric)] merely increases the number of indicia used in selection (e.g. 26 letters [or 36 for alphanumeric] rather than ten digits, 0-9) thereby decreasing percentage of player matching all indicia, thus increasing maximum award resulting from the decreased percentage of matching all indicia. The decrease in probability causes an increase in size of jackpot that may attract more people to play since large jackpot amounts tend to increase play. As evidence of use of game using a plurality of words, see Baerlocher (1:21-27, 4:4) or Walker (4:18-19, 23-35). Further, the use of a plurality of words rather than a sequence of numbers likewise decreases probability of matching for similar reasons as use of letters rather

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than numbers; however it is noted that a plurality of words is like a sequence of digits in so far as in lottery a sequence is selected for comparison to system selected winning sequence for win determination and each unit of sequence of digits is analogous to a word in a plurality of words. Thus, the form of indicia being an alphabetical play phrase comprising a plurality of words fails to patentably distinguish over Koza or over Koza in view of either Baerlocher or Walker, or over Koza in view of either Goldman or Luciano and further in view of either Baerlocher or Walker. The claimed apparatus and method use of a alphabetical play phrase comprising a plurality of words as indicia in lottery game does not patentably distinguish over either a sequence of numbers by Koza (or Koza in view of either Goldman or Luciano) or a plurality of words as suggested by Koza in view of either Goldman or Luciano and further in view of either Baerlocher or Walker since neither is the claimed apparatus modified by use of differing indicia nor does the process of play change as noted above. Alternatively, Koza lacks a plurality of words. Koza discloses a plurality of indicia selected by player to match with system selected indicia to assess/determine degree of match between player selected indicia and system selected indicia where indicia is either numbers or letters (sic). Baerlocher or Walker each teach apparatus for playing a game that includes a phase comprises a plurality of words (sic). It would have been obvious to an artisan at a time prior to the invention to add a plurality of words as suggested by either Baerlocher or Walker to Koza or to Koza in view of either Goldman or Luciano to increase complexity of winning combination that decreases probability of winning thereby increasing jackpot amount and increasing number of players playing lottery game since large jackpot amounts attract players. The combination taken as a whole at a time prior to the invention suggests to an artisan an apparatus for playing a lottery game with game input for

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receiving a random alphabetical play phrase from a user comprising a plurality of words, a wager input device and a processor as particularly claimed.

5. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Koza in view of either Baerlocher or Walker, alternatively over Koza in view of either Goldman (4157829) or Luciano (6168521) and each further in view of either Baerlocher or Walker, as applied to claim 30 above, and each further in view of Casa (5613679). Discussion above regarding breadth of claim language is incorporated herein. Response to Applicants remarks is provided below and incorporated herein. As best understood, where alphabetic play phrase fails to preclude a player selected word or letter or alphanumeric sequence (*supra*), Koza in view of either Baerlocher or Walker or, Koza in view of either Goldman or Luciano and further in view of either Baerlocher or Walker suggests to an artisan at a time prior to the invention an apparatus for lottery game comprising all features (*sic*) including a lottery play slip (11:64-68, 12:46-13:2, 13:26-35) and a selection section allowing alphabetical play phrase to be coded (12:46-13:2 and 26-35) except a first section containing the alphabetical play phrase. Koza relies upon conventional play slip format for reading input (11:64-68, 12:46-13:2, 26-35) and as such does not further disclose details of a conventional lottery play slip, thus any conventional play slip may be used. Also, Goldman or Luciano each discloses use of lottery play slip or at least permits other lottery schemes and techniques but lacks detailing format of play slip to include a first section and a selection section. Casa discloses a method of playing a lottery game teaching a conventional play slip having a selection section to allow the string to be coded by player. Regarding the first section, it is notoriously well known (by OFFICIAL NOTICE) to permit user input via hand written input in conjunction with a selection section to be user coded of the written input where

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the hand written input allows quick visual verification of hand written input to ensure intended player/user response of player coded input while the coding allows machine reading. Thus, it would have been obvious to an artisan at a time prior to the invention to add a first section containing the play phrase, as notoriously well known and a selection section as conventional or as taught by Casa to Koza in view of either Baerlocher or Walker or, alternatively, to Koza in view of either Goldman or Luciano and further in view of either Baerlocher or Walker no to utilize known play slip format thereby saving development costs, for ease of play by players due to familiarity of game format and to permit quick visual verification of coded input.

6. Claims 34-35, 37 and 40-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koza (5112050) in view of either Baerlocher or Walker as applied to claim 29 above, and further in view of Roberts (5772510) or, alternatively, over Koza in view of either Goldman (4157829) or Luciano (6168521) and further in view of either Baerlocher or Walker, as applied to claim 29 above, and further in view of Roberts (5772510). Discussion above regarding breadth of claim language is incorporated herein. As best understood, Koza in view of either Baerlocher or Walker, or alternatively, Koza in view of either Goldman or Luciano and further in view of either Baerlocher or Walker suggests a word based lottery game comprising claimed steps/features (*supra*) including the play phrase being same as the alphabetical play phrase wherein if the character string matches a word in the alphabetic play phrase, the user wins a prize associated with the word and a prize is associated with each word in the phrase (12:36-68) but lacks a printer generating a lottery ticket (claim 34), having a section listing the alphabetic play phrase and a covered section including the random character string (claim 35), and wherein the covered section can be removed to reveal the random character string (clm 37). Lottery tickets

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having a covered section including the random character string that can be removed to reveal the character string and a printer generating such a lottery ticket by OFFICIAL NOTICE are notoriously well known (i.e. conventional) such as used in pull tab or scratch off games. Koza further discloses lottery games that include elaborate systems to conceal preprinted combination of indicia so that the preprinted combination is revealed only after purchasing the ticket such as scratching off a masking layer (2:47-3:21, 13:26-30) as a general discussion of a conventional scratch off lottery ticket. Roberts (abstract, 1:58-3:4, 4:14, 22-46, figs. 1-8B, ref 19) discloses a lottery ticket and system having a printer (ref. 19) generating a lottery ticket (ref. 12) having a section listing player picks (3:42-5:2) and a covered section having the random character string (Figs 2A-2B, ref 29) for increasing security by completing printing lottery ticket only after sale. Therefore, it would have been obvious to an artisan at a time prior to the invention to add a printer generating a lottery ticket where the lottery ticket includes a section listing the alphabetic play phrase and a covered section including the random character string wherein the covered section can be removed to reveal the random character string as known in predetermined lottery games or as taught by Roberts to Koza in view of either Baerlocher or Walker or, alternatively, to Koza in view of either Goldman or Luciano and further in view of Baerlocher or Walker to increase security by only completing the printing of the lottery ticket after purchase (3:1-4).

7. Claims 38-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koza (5112050) in view of either Baerlocher or Walker as applied to claim 29 above, and further in view of Roberts (5772510) as applied to claim 35 above or, alternatively, over Koza (5112050) in view of either Baerlocher or Walker as applied to claim 29 above, and further in view of Roberts (5772510) as applied to claim 35 above and further in view of Guttin (6241246) or,

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alternatively, over Koza in view of either Goldman (4157829) or Luciano (6168521) and further in view of either Baerlocher or Walker, as applied to claim 29 above, and further in view of Roberts (5772510) as applied to claim 35 above, and further in view of Guttin (6241246). Koza in view of either Baerlocher or Walker, and further in view of Roberts or, alternatively, Koza in view of either Goldman (4157829) or Luciano (6168521) and further in view of either Baerlocher or Walker, and further in view of Roberts (5772510) suggests claimed apparatus including a prize associated with each word in the alphabetical play phrase as determined by lottery pay schedule (Koza, 3:10-20, 7:36-41, 64-66, 8:4-5 and 9-11, 12:35-68). With respect to 'a prize is associated with each word in the alphabetical play phrase', Koza teaches awarding a prize for matching selected indicia (3:10-20, 7:36-41, 64-66, 8:4-5 and 9-11, 12:35-68). It is noted that a prize associated with each word in the alphabetical play phrase includes matching indicia to determine a prize based in part on degree of matched symbols such as matching numbers in lottery such as taught by Koza, Goldman, or Luciano in so far as degree of matching determines amount of prize won in that a prize is 'associated' with each match (Koza, 7:36-41, 64-66, 8:4-5, 9-11; Goldman, Tables I-IV; Luciano, 9:9-16). Also, the phrase 'wherein... play phrase' fails to limit structure of apparatus since this functional limitation pertains to process of play or use of apparatus rather than to structure of apparatus and Koza teaches awarding a prize based on correlation of matched symbols/indicia (sic). MPEP 2111.04, 2114. However, alternatively, further, Guttin discloses a lottery ticket having a plurality of words (ref 4, 6, 8) wherein a prize is associated with each word (ref. 8), and similarly, conventional lottery pay schedule associate a prize with correlation of number of match indicia (Koza, 7:36-41, 64-66, 8:4-5, 9-11; Goldman, Tables I-IV; Luciano, 9:9-16). Therefore, it would have been obvious to

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an artisan at a time prior to the invention to add a prize is associated with each word as taught by Guttin to Koza in view of either Baerlocher or Walker and further in view of Roberts or, to Koza in view of either Goldman and Luciano and further in view of either Baerlocher or Walker and further in view of Roberts to increase the complexity of game and to award prize based in part on number of matched words as conventional for awarding prize based on number of matched indicia in lotto games. Also, with respect to 'wherein the prize associated with each word may be changed by the user', similarly this limitation pertains to process of play or use of apparatus rather than structure of apparatus, and it is noted that determination of pay schedule of lotto game is based on format (i.e. pick-3, pick-4, pick-6, keno) which each implicitly based on a player switching between games causes a change by the user of prizes (pay schedule) in that each lotto game implicitly includes a different prize associated with its associated symbols of stated differently, each differing lottery game format implicitly includes a prize schedule to award a prize based on degree of matching of symbols/indicia that would include the particular indicia of game such as numbers, letters, alphanumeric or words that is inclusive of prize associated with each word may be changed by user based on different lottery game format (i.e. pick-3, pick-4, pick-6, keno). Essentially, the breadth of claim language includes and fails to preclude the implicit change of prize or pay schedule in switching from one form of lottery to another lotto game where word in this case is the symbols or indicia used such as letters, numbers alphanumeric or words or likewise each lottery format implicitly includes a prize schedule for awarding a prize that may be changed by user in formulation/development of the game format. The breadth of claimed apparatus and its process of play fail to preclude conventional lotto schemes/prizes.

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8. Claims 42-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koza in view of either Baerlocher (5788573) or Walker (5921864). Discussion above regarding breadth of claim language is incorporated herein. As best understood, Koza discloses a method for playing word based lottery game comprising claimed steps (sic) that includes receiving an alphabetical play phrase from a user as either word or letter or alphanumeric sequence (3:10-20, 6:21-29, 11:28-40, 64-67, 12:35-68), where receiving is either via play slip or receiving indicia keyed manually by user or selection from a menu of phrases, as a word or alphanumeric sequence, (11:36-38, 12:36-13:2, ref 72), receiving a wager via coin slot (11:40), generating a random character string (3:10-20, 5:26-28, 31-32, 49-54, 6:29-32, 44-48, 7:26-34, 8:24-25, 12:36-13:2), determining a correlation among the alphabetical play phrase (3:10-20, 6:32-43, 12:35-68), the random character string and the wager (supra), determining a payout value based upon, at least, the correlation (3:10-20, 6:37-39, 7:36-41, 8:9-11, 12:35-68), but Koza lacks a plurality of words. A phrase having a plurality of words in a game of chance as taught in Wheel of Fortune phrase game as discussed by either Baerlocher (1:21-27, 4:4) or Walker (abstract, 4:18-19, 23-35). Also, a phrase comprising a plurality of words increases complexity of game over a game that uses a phrase comprised of a single word that would decrease probability of a player selecting the phrase and increase the jackpot amount due to the decreased probability. The increase in jackpot amount attracts more players which increases revenue for operator. Thus, it would have been obvious to an artisan at a time prior to the invention to add a plurality of words as suggested by Baerlocher or Walker to Koza so as to increase interest from players for particular topic or theme. Essentially, in this case, the particular indicia selected by player or generated as winning combination fails to patentably distinguish over Koza at least since games

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of chance that include a phrase having a plurality of words are known such as phrase game taught by either Baerlocher or Walker suggest a phrase comprising a plurality of words so as to increase the complexity of game and increase size of jackpot prize due to decreased probability of winning. Essentially, the difference between Koza and claimed invention is the particular indicia comprising a plurality of words. Altering the number of indicia selected or to be selected does not patentably distinguish as noted in lottery there is a multitude of pick-X schemes that suggest increasing number of indicia to be matched increases jackpot size due to increased complexity of matching higher number of indicia that causes a decrease in probability. An increase in size of jackpot generally attracts more players to play lotto game (sic) and thus would further be evidence of obviousness to alter indicia of Koza to include a plurality of words as known or as suggested by either Baerlocher or Walker to increase player interest.

9. Claim 46 is rejected under 35 U.S.C. 103(a) as being unpatentable over Koza (5112050) in view of either Baerlocher or Walker as applied to claim 42 above, and further in view of Roberts (5772510). Koza in view of either Baerlocher or Walker suggests a method comprising claimed steps (supra) including associating a prize with each word and wherein if the character string matches a word in the alphabetic play phrase, the user wins a prize associated with the word and a prize is associated with each word in the phrase (3:10-20, 12:36-68) except printing a word based lottery ticket comprising a section listing the alphabetic play phrase and a covered section including the random character string. Koza further discloses lottery games that include elaborate systems to conceal preprinted combination of indicia so that the preprinted combination is revealed only after purchasing the ticket such as scratching off a masking layer (2:47-3:21, 13:26-30) as a general discussion of a conventional scratch off lottery ticket.

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However, Roberts discloses a lottery ticket (abstract, 1:58-3:4, 4:14, 22-46, figs. 1-8B, ref 19) teaching a ticket printer (ref. 19) generating a lottery ticket (ref. 12) having a section listing play data or indicia (3:42-5:2, ref 26a, 26b) and a covered section having the random character string (Figs 2A-2B, ref 24, 24b) for increasing security by completing printing lottery ticket only after sale. Therefore, it would have been obvious to an artisan at a time prior to the invention to add a printing a lottery ticket where the lottery ticket also includes a section listing the alphabetic play phrase, a covered section including the random character string as known in predetermined lottery games or as taught by Roberts to Koza in view of either Baerlocher or Walker to increase security by completing the printing of the lottery ticket after purchase (3:1-4).

10. Claims 47-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koza (5112050) in view of either Baerlocher or Walker, and further in view of Roberts (5772510) as applied to claim 46 above, and further in view of Guttin (6241246). Koza in view of either Baerlocher or Walker and further in view of Roberts suggests a method for playing a lottery game comprising claimed steps (sic) including associating a prize with each word, determining a match between the random character string and play phrase wherein if the character string matches a word in the alphabetic play phrase, the user wins a prize associated with the word and awarding a prize based on the match to the user (3:10-20, 6:37-39, 7:36-41, 8:9-11, 12:35-68).

Alternatively, Guttin discloses an apparatus for playing a word based lottery game or method teaching associating a prize with each word, determining a match between the random character string and the plurality of words, and awarding a prize to the user (ref. 4, 6, 8) such that based on number of matched words a predetermined prize value is awarded. Therefore, it would have been obvious to an artisan at a time prior to the invention to add associating a prize with each

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word, determining a match between the random character string and play phrase wherein if the character string matches a word in the alphabetic play phrase, the user wins a prize associated with the word and awarding a prize based on the match to the user as taught by Guttin to Koza in view of either Baerlocher or Walker and further in view of Roberts so as to award a prize in part on matched words.

Response to Arguments

11. Applicant's arguments with respect to claims 29-35, 37-50, 52-53 have been considered but are moot in view of the new ground(s) of rejection.

12. Applicant's arguments filed Aug 23, 2007 have been fully considered but they are not persuasive. Applicant's admission on page 14 that a phrase can include a single word is noted. However, the examiner is confused by the Applicant's assertion that the Office action states each and every word may be a phrase since reading the prior action, there is no such statement. The holding of anticipation by Koza in prior action was for those instances where the word selected from a menu in Koza was also a phrase. The examiner is also confused by Applicants attempt to redefine scope of their specification and inquires as to basis that 'alphabetical' prohibits alphanumeric sequences where the claimed invention is open-ended due to 'comprising' and the discussion regarding lotto games within Applicants originally filed specification includes numbers (paragraphs 44, 57, 62-63, 78, 81, 85) and nowhere states an exclusion with respect to word-based lotto game. Applicant is reminded that their right as being a lexicographer was not exercised in this case (paragraph 31). Also, alphabetical play phrase includes letters but does not implicitly, inherently or explicitly exclude numbers since there is no stated exclusion for numbers in lottery game, or word based lotto game or for alphabetical play phrase in Applicant's

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originally filed disclosure (paragraph 31). As further documented that numbers is included as intrinsic evidence, paragraph 81 states play phrase may be as an example film titles. Film titles include numbers as for example '12 Angry Men', '12 O'Clock High', '9 to 5', '10,000 Leagues Under the Sea', etc. that are text as well as film title and each may be an alphabetical play phrase by instant disclosure. Thus, the originally filed specification includes an alphanumeric sequence for each of disclosed lotto games including word based lotto game. Applicant's argument is neither persuasive nor well taken.

In response to Applicant's remark for claim 29 and its dependent claims that Koza lacks a plurality of words, the claimed invention is an apparatus and an apparatus must be differentiated by its structure not its manner of use. The office maintains that the structure claimed is taught by Koza either implicitly or explicitly since Koza teaches a lotto game that uses a word which in those instances that the word also is a phrase, having a game input unit, a wager input device and a controller (sic). Alternatively, the use of a plurality of words is maintained as design choice for altering probability or odds of game similar to the various lotto (pick-3, pick-4, pick-6, keno) games having a differing number of indicia (i.e. numbers) selected for altering odds based on number of indicia to be matched and the ranges of numbers being used. Baerlocher or Walker each suggests games of chance having use of a plurality of words in a phrase. Thus, the combination (Koza in view of Baerlocher or Walker or, Koza in view of either Goldman or Luciano and further in view of either Baerlocher or Walker) taken as a whole at a time prior to the invention suggests to an artisan a lottery game that receives a alphabetical play phrase from a user comprising a plurality of words so as to increase jackpot size resultant from the decrease in probability to match.

In response to applicant's argument with respect to claim 42 and its dependent claims that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the examiner disagrees with Applicants assertion that the references teach away from claimed invention since the standard of patentability remains as what the combination of prior art suggests to an artisan taken at a time prior to the invention. Koza, Baerlocher and Walker each teach a method of play, but this does not teach away from invention. In this case, Koza discloses a lottery game where the player selects the indicia to match via game input of either play slip or keyboard (3:10-20, 3:50-52, 6:9-29, 11:36-38, 11:60-68, 12:46-63, ref 72); while, either Baerlocher or Walker each suggest use of phrase comprising a plurality of words in a chance game. Although the phrase is hidden in either Baerlocher or Walker, the office is not relying on player selection from either of those references, since player selection of a phrase is taught by Koza since as applicant admits a word may be a phrase in those instances that the word is a phrase and Koza includes player selection of a phrase by selection of a word in those instances that the word is a phrase. Thus, the combination taken as a whole at a time prior to the invention suggests to an artisan a lottery game where a user selects a phrase comprising a plurality of words on an input device. As further evidence only, although not deemed necessary for holding, Sarno further provides

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evidence of lottery game where a user selects a plurality of words as indicia to match as by use of the plural form 'words' (5:45-52).

In response to Applicant's assertion for claim 50 and 52-53 that Guttin lacks a prize is associated with each word in the pre-printed play phrase, the examiner disagrees and notes Applicants failure to consider breadth of claimed invention and teachings of Guttin is not persuasive. Essentially, the claimed ticket is an apparatus and must be differentiated by structure (MPEP 2114); however, the claim language 'whereby a prize is associated with each word in the... phrase' is functional recitation pertaining to manner of use or play. Guttin discloses a ticket having a section listing a alphabetic play phrase as any text comprised of a plurality of words (ref 4) and a random character string having a cover being selectively removable to reveal random character string (ref 6), whereby a prize is associated with each word (ref. 8), wherein the random character string selectively matches a word in the pre-printed play phrase whereby upon such matching a prize associated with the word is won (ref 8), or wherein the random character string selectively containing all characters of a word in the pre-printed play phrase whereby a prize associated with the word is won (ref. 4, 6, 8), as broadly claimed. Essentially, the claimed invention includes and fails to preclude Guttin in that Guttin includes a pay schedule that associates a prize with each word in the play phrase (ref 4, 6, 8), as broadly claimed. It is noted that Applicants disclosure includes a play phrase being a list of words fitting a theme (paragraph 81) that is maintained Guttin teaches by use of a word find theme such that the listing of words conform to a theme as common for word find games as noted in background of Guttin or by Chan or, alternatively, use of a plurality of words in a phrase in games of chance is known

as suggested by either Baerlocher or Walker. Discussion above with respect to Koza regarding 'associated' is incorporated herein as relevant to claim scope interpretation with respect to Guttin.

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

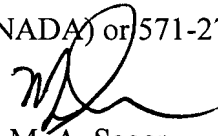
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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. A. Sager whose telephone number is 571-272-4454. The examiner can normally be reached on T-F, 0700-1730 hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on 571-272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



M. A. Sager
Primary Examiner
Art Unit 3714

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